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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|------------------------|---------------------|------------------|
| 10/561,637   | 12/19/2005  | Yoshimichi Kawai       | 52433/831           | 2907             |
| 26646 7590 12/22/2008<br>KENYON & KENYON LLP<br>ONE BROADWAY<br>NEW YORK, NY 10004 |             |                        |                     |                  |
| EXAMINER<br>GILBERT, WILLIAM V   |             |                        |                     |                  |
| ART UNIT<br>3635   |             | PAPER NUMBER           |                     |                  |
| MAIL DATE<br>12/22/2008  |             | DELIVERY MODE<br>PAPER |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/561,637

**Applicant(s)**

KAWAI ET AL.

**Examiner**

William V. Gilbert

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/02)
- Paper No(s)/Mail Date 12/19/05.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This is a first action on the merits. Claims 1-3 are pending.

***Claim Objections***

1. **Claim 1** is objected to because of the following informalities: line 3, "71" should be in parenthesis, i.e., "(71)". Reference numerals in a claim should be placed in parenthesis. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-3** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, the limitation in the last paragraph has the wainscot panel integrated with upper and lower parts of the side face wall. It is unclear in light of the disclosure how this is possible. Applicant should either clarify or otherwise amend the claim. For examination purposes, the examiner interpreted, in light of the disclosure, that the vertical panel was to integrate with upper parts of the side face wall and the wainscot panel integrates with lower parts of the side face wall.

Regarding claims 2 and 3, the limitation "face members...tensioned" (e.g. claim 2, line 3) lacks enablement, as applicant has not provided in the specification any disclosure as to what constitutes the tensioned members or how the members are tensioned as claimed. It is completely unclear how the members are to undergo tensioning.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-3** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. The examiner examined the claims as best understood in light of the specification.

**Claim 1** recites the limitation "said face walls" in line 17. There is insufficient antecedent basis for this limitation in the claim. This is just one example, as the claims are replete with grammatical and antecedent issues.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere* Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35

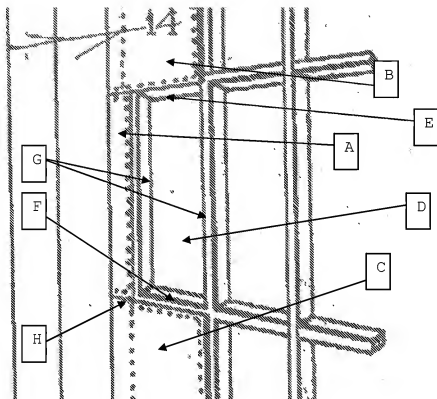
U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 1-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Odell (U.S. Patent No. 2,291,498) in view of Bailey (U.S. Publication 2003/0145537) and Howell (U.S. Patent No. 4,869,040).

Claim 1: Odell discloses a construction of an opening (see Fig. 6: below) comprising a side face wall frame member ("A" below), a vertical panel ("B" below) and a wainscot panel ("C" below), the side face wall frame members comprise an opening ("D" below) formed by an opening upper frame member ("E") to which a lower end of the vertical panel is fixed (as shown), an opening lower frame member ("F") to which an upper end of the wainscot panel is fixed (as shown), a longitudinal frame member ("G") raised on both on both sides of the frame members, and transverse frame members (not shown, but proximate "H" below), the vertical panel (se 35 USC §112 rejection above) is integrated with upper parts of the side face wall and the

wainscot panel are integrated with lower parts of the side face wall (as shown). Odell does not disclose the limitation of having two side face wall members (i.e., a member equivalent to "A" on the other side of the opening,) which would result in the side face members being divided. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of duplication of parts to have this limitation because duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669 (CCPA 1960). See MPEP §2144.04. Odell further does not disclose the additional longitudinal members as claimed, though Bailey discloses longitudinal members (1) in pairs around a window opening. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have additional members as claimed for further strengthening the opening as needed. Odell further does not disclose that the members are made of steel, though Howell discloses a steel framing system (Col. 1, generally). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the steel system in Howell as for the framing system in Odell because it is well known in the art to use steel framing due to its strength and durability and longer life over its wood counterpart.



**Figure 6 from Odell**

Claims 2 and 3: the vertical panels and wainscot panels can be tensioned through a number of means: gravity, wind, being attached to the wall (as applicant has not disclosed how the panel undergoes tensioning, the examiner interpreted it as broadly as reasonable,) and while the Bailey reference teaches two longitudinal members for reinforcement, it does not disclose the reinforcing members in the locations as claimed. It would



have been obvious at the time the invention was made to a person having ordinary skill in the art to have additional reinforcement (such as a second longitudinal member) located as claimed because Bailey teaches placing members in pairs (see Fig. 14: 1) which would result in a stronger structure. The members are bonded through the fasteners as shown in Odell (e.g., nails.)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635  
/Basil Katcheves/  
Primary Examiner, Art Unit 3635